

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FLORENCE RUGLESS

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Appeal No. 2001-1074  
Application No. 08/989,056

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ON BRIEF

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Before COHEN, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 11, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to oxygen masks that can serve the purpose of a regular oxygen mask, an aerosol oxygen mask, and a non-rebreather oxygen mask (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Engelder 1953	2,625,155	Jan. 13,
Schnoor 1989	4,832,017	May 23,
Niemeyer 1990	4,951,664	Aug. 28,
Nutter 1991	5,025,805	June 25,
Galleher, Jr. 1961 (Galleher)	618,808  (Canada)	Apr. 25,

Claims 1 to 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 to 3, 7, 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Galleher in view of Engelder.

Claims 4 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Galleher in view of Engelder and Niemeyer.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Galleher in view of Engelder and Schnoor.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Galleher in view of Engelder and Nutter.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 17, mailed July 19, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 16, filed July 6, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**The indefiniteness rejection**

We will not sustain the rejection of claims 1 to 11 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of

terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

With this as background, we have reviewed the specific objections under 35 U.S.C. § 112, second paragraph, raised by the examiner (answer, pp. 3-4) but fail to see how the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty especially since the mere breadth of a claim does

not in and of itself make a claim indefinite.<sup>1</sup> Thus, we find ourselves in agreement with the position of the appellant (brief, p. 4) that the claims under appeal are definite, as required by the second paragraph of 35 U.S.C. § 112, since they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed.

#### **The obviousness rejections**

We will not sustain the rejection of claims 1 to 11 under 35 U.S.C. § 103.

Claim 1, the only independent claim on appeal reads as follows:

A multi-purpose oxygen face mask comprising:  
a mask body;

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<sup>1</sup> Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

a head strap connected to said mask body at a right head strap attachment point extending from said mask body around the rear of a patient's head and connects with said mask body at a left head strap attachment point, and wherein said right head strap attachment point and said left head strap attachment point allow for rotation around the connection point [sic, the right and left head strap attachment points] of the mask body and said head strap;

a lower neck strap connected at a right lower neck strap attachment point and extending around the rear of a patient's neck with the opposite end of said lower neck strap, opposite said right lower neck strap attachment point, connecting to a left lower neck strap attachment point, located on said mask body, opposite said right lower neck strap attachment point;

a right lower port, said right lower port located on the lower right portion of said mask body near the patient's nose and mouth area;

a right lower port cap; said right lower port cap covering said right lower port via a friction fit;

a right upper port; said right upper port located directly above said right lower port;

a right upper port cap; said right upper port cap covering said right upper port via a friction fit;

a left lower port, said left lower port located on the lower, left portion of said mask body near the patient's nose and mouth area;

a left lower port cap, said left lower port cap covering said left lower port via a friction fit;

a left upper port; said left upper port located directly above said left lower port; and

a left upper port cap, said left upper port cap [, said left upper port cap] covering said left upper port via a friction fit.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of



obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting **evidence** that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

**Evidence** of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed.

Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In the rejection of claim 1 before us in this appeal, the examiner concluded (answer, pp. 4-5) that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to (1) use the four port system of Engelder with the mask of Galleher, and (2) supply four friction engaging port caps instead of the two friction engaging port caps taught by Engelder since such is a duplication of parts.

We agree with the examiner that it would have been obvious at the time the invention was made to a person of

ordinary skill in the art to use the four port system of Engelder with the mask of Galleher. However, in the rejection before us in this appeal, the examiner has not presented any **evidence** establishing that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to supply four friction engaging port caps instead of the two friction engaging port caps taught by Engelder. In that regard, there is no **evidence** that it would have been obvious to close each of Engelder's ports provided by nipples 33 and 34 with a friction engaging port cap especially since the ports provided by Engelder's nipples 33 and 34 are open when the mask is in use.

For the reasons set forth above, the combined teachings of Galleher and Engelder are insufficient to establish the obviousness of the subject matter of claim 1. We have also reviewed the references additionally applied in the rejections of claims 4 to 6, 8 and 9 (i.e., Niemeyer, Schnoor and Nutter) but find nothing therein which makes up for the deficiencies of Galleher and Engelder discussed above. Accordingly, the

decision of the examiner to reject claim 1, and claims 2 to 11 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed and

the decision of the examiner to reject claims 1 to 11 under  
35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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JOHN D. GUGLIOTTA  
SUITE 202  
137 SOUTH MAIN STREET  
AKRON, OH 44308

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